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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,336	10/31/2003	Ashis K. Saha	1282-P03035US1	5398

110 7590 04/15/2005

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EXAMINER

COVINGTON, RAYMOND K

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,336

Applicant(s)

SAHA ET AL.

Examiner

Raymond Covington

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 in part, drawn to benzofuranyl compounds of formula I with on other heterocyclic substituents, including its pharmaceutical salts and pharmaceutical compositions, classified in class 549, subclass 468, for example. A single disclosed species is requested for search purposes.
- II. Claims 1-11 and 14 in part, drawn to products of formula I where R_2 or R_3 is morpholine, including its pharmaceutical salts, and pharmaceutical compositions, classified in class 544, subclass 153, for example. A single disclosed species is requested for search purposes.
- III. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is isoxazole, classified in class 548, subclass 237, for example. A single disclosed species is requested for search purposes.
- IV. Claims 1-11 in part, drawn to triazole products of formula I where R_2 or R_3 is triazole, classified in class 548, subclass 180, for example. A single disclosed species is requested for search purposes.

- V. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is tetrazole, classified in class 548, subclass 253, for example. A single disclosed species is requested for search purposes.
- VI. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is imidazole, classified in class 548, subclass 311.4, for example. A single disclosed species is requested for search purposes.
- VII. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is oxadiazole, classified in class 548, subclass 237, for example. A single disclosed species is requested for search purposes.
- VIII. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is thiadiazole, classified in class 548, subclass 131, for example. A single disclosed species is requested for search purposes.
- IX. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is thiazole, classified in class 548, subclass 181, for example. A single disclosed species is requested for search purposes.
- X. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is pyrrole, classified in class 548, subclass 525, for example. A single disclosed species is requested for search purposes.

- XI. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is piperidine, classified in class 546, subclass 196, for example. A single disclosed species is requested for search purposes.
- XII. Claims 1-11 in part, drawn to products of formula I where R_2 or R_3 is heterocyclic other than groups II-XI, classified in class 549, subclass 60, for example. A single disclosed species is requested for search purposes.
- XIII. Claims 13-15 are drawn to pharmaceutical compositions of claim 1 and a pharmaceutically acceptable carrier, classified in multiple classes and subclasses. This group may be subjected to further restriction.
- XIV. Claims 16 are drawn to pharmaceutical compositions of claim 1 containing 2+ active ingredients and a pharmaceutically acceptable carrier, classified in multiple classes and subclasses. This group may be subjected to further restriction.
- XV. Claims 17-22 and 27, in part, are drawn to a method of treating hepatitis C using compounds embraced by formula I or its salts as described in claim 1, classified in class 514 and multiple subclasses.

This group may be subjected to further restriction. A single disclosed species is requested for search purposes.

XVI. Claims 23-26, in part, are drawn to a method of treating hepatitis C using 2+ active ingredients including compounds embraced by formula I or its salts as described in claim 1, classified in class 514 and multiple subclasses. This group may be subjected to further restriction. A single disclosed species is requested for search purposes.

The inventions are distinct, each from the other because of the following reasons:

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case inventions I-XII are unrelated and different inventions since each one of the said groups are drawn to compounds having a particular three heterocyclic ring containing core per group, the compounds embraced in each group have its own reactivity, structure and variable groups. The terms A, R₁-R₇ have so many variables and hence so many permutations and combinations that a prior art reference anticipating the claims with respect to one member under 35 USC 102(b)

would not render obvious the same claims under 35 USC 103a with respect to another member. The search for each group is different and a reference anticipating or suggesting a given group cannot be used to reject any of the others under the meaning of 35 USC 102 or 35 USC 103. See , for example Chem. Abstract vol. 132 no. 222445.

Inventions 1-XII (products) and XIII (composition) are related as product and composition containing the product. The products, previously shown to be distinct, can be practiced with another materially different product from one of groups I-XII. If the compounds of an elected group are found allowable then group XIII to the extent of the scope of the elected group can be rejoined with the elected group.

Inventions 1-XII (products) and XIV (composition) are related as product and composition containing multiple active ingredients. The products, previously shown to be distinct, can be practiced with another materially different product from one of groups I-XII.

Inventions XV and any one of groups I-XII are unrelated because each one of the said groups are drawn to methods treating a condition using different sets of compounds embraced by different groups already shown above to be a separate and distinct inventions.

Inventions XVI and any one of groups I-XII are unrelated because each one of the said groups are drawn to methods treating a condition using different sets of compositions having multiple ingredients embraced by different groups already shown above to be a separate and distinct inventions.

Inventions XV and XVI are unrelated because each one of the said groups are drawn to using different sets of multi-component active ingredient compositions embraced by different groups already shown to be a separate and distinct inventions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for any group is not required any of the others, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be

accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process of use claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, a withdrawn process of use claim that depends from or otherwise includes all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejections are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not

be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (571) 272-0681. The examiner can normally be reached on M-F.

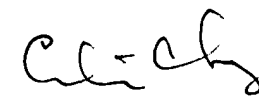
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Tsang can be reached on (571) 272-0562. The fax

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Covington
Examiner
Art Unit 1625


RKC


CEILA CHANG
PRIMARY EXAMINER, Acting SPE
GROUP 1200
1625